<u>REMARKS</u>

As may be appreciated from the listing of claims provided above, claims 23 and 29 have been amended herein to correct informalities. The amendment merely places these claims in a better condition for appeal. For instance, claim 29 was amended to insert the term "the" into claim 29 and claim 23 was amended to include the term "wherein". The scope of the claims is not affected by the amendment. It is respectfully requested that the amendment of the claims be entered.

No additional fees are believed to be required for the present Amendment. Nevertheless, Authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. RESPONSE TO THE REJECTION OF CLAIMS ISSUED UNDER 35 U.S.C. § 103 IN THE OFFICE ACTION

Claims 12-31 were rejected in the Office Action of December 17, 2010 (hereafter "Office Action") under 35 U.S.C. § 103 in view of Microsoft Outlook 2002, the Windows XP OS system of October of 2001 and U.S. Patent Application Publication No. 2004/0158607 to Coppinger et al. (Office Action, at 2).

A. <u>Burden Of Proving Obviousness Under 35 U.S.C. § 103</u>

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and given weight**." MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on

35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 82 USPQ2d at 1396) (emphasis added).

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B.   Claims 12-17 And 23-26 Are Allowable

Currently pending claim 12 requires a method for processing an electronic message to include opening an electronic message, saving at least one file attachment of the electronic message in a user-selected memory location, replacing the at least one file attachment in the electronic message with at least one first link when the at least one file attachment is saved via actuation of a save as and link command, creating a second link to the electronic message when the at least one file attachment is saved via actuation of a save as and link command, and saving the second link in the user-selected memory location where the file attachment is also stored when the at least one file attachment is saved via actuation of a save as and link command. The first link is configured to display the at least one file attachment after the at least one first link is actuated. The second link is configured to display the electronic message after that second link is actuated. Claims 13-17 and 23-26 depend directly or indirectly from claim 12 and therefore also contain these limitations.

1.   The Cited Art Does Not Teach Or Suggest The Creation Of A Link To An Electronic Message And Saving Of That Link In A File In Which A File Attachment Is Saved When That File Attachment Is Saved

The Examiner has cited Microsoft Outlook 2002 and Windows XP as teaching and suggesting saving a link to an electronic message where an attachment file may be saved. (Office Action, at 2-3). However, the cited art does not teach or suggest all the limitations of the pending claims

Microsoft Outlook 2002 and XP do not teach or suggest any saving of an attachment and also creating a link to the electronic message that initially has such an attachment when the

attachment is saved. For example, there is no "save as and link" command or functionality provided by Outlook 2002 and XP as noted in paragraphs 24-35 of the specification.

As may be appreciated from the screen shots of Figures 1-13 provided by the Examiner in the Office Action, a user must manually save an email to a desktop, then create a short cut link, then save the short cut link in the file in which an attachment is stored to be able to even save such a short cut in that file location by using Outlook 2002 and XP. There is no saving of an attachment while also creating and saving a link to the electronic message in the same file the attachment is saved in that occurs when the attachment is saved.

Further, Coppinger et al. do not teach or suggest any message links or other links that refer to an electronic message nor the saving of such links in a file or other location in which an attachment from that electronic message is saved. In fact, the Examiner has correctly recognized that the Coppinger et al. reference only deals with attachments of electronic messages. (Office Action, at 4).

The cited art fails to teach or suggest all the limitations of claims 12-31. These claims are allowable over the cited art.

2. The Examiner Has Failed To Show That XP And Outlook Utilize The Claimed Method

Further, the Examiner has failed to show that the claimed method has actually ever been used. The Examiner has argued that Microsoft XP and Outlook 2002 provide functionality that could permit the method to be practiced. However, none of the cited art teaches or suggests that such functionality be used. This is particularly true when there are so many steps required for a user to actually perform such a method using XP and Outlook.

The Examiner has not provided any evidence showing that the method of claims 12-17 and 23-26 has been taught or is used in the prior art. For example, no reference or other art relied on by the Examiner shows that the steps shown in Figures 1-12 in the Office Action were ever practiced in the prior art. The Examiner's rejection merely argues that such functionality *could* permit a user to practice the method of the previously presented claim 12.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert,* 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981); MPEP § 2112.

Applicants understand the Examiner to argue that XP and Outlook inherently disclose the method of creating a link to an electronic message and saving that link in the same file as a file attachment of the electronic message is saved. However, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP 2112. At best, the Examiner has merely showed that a certain thing may result, not that is has resulted or was ever practiced. As found by the Federal Circuit in *In re Robertson*, and as stated in § 2112 of the MPEP, such evidence is insufficient to reject the pending claims.

For at least the above reasons, claims 12-17 and 23-26 are allowable over the cited art.

3.   The Prior Art Does Not Teach Any Saved As And Link Command Nor The Functionality Associated With That Comman As Required By Claims 12-17 And 23-26

None of the cited art teaches or suggests any saved as and link command as required by the pending claims. The mere fact that Windows XP permits a user to create a shortcut and the Outlook 2002 permits a user to save an attachment to a file does not teach or suggest any saved as and linked command that requires a saving of a file and the creation of at least one first link and a second link as required by claims 12-17 and 23-26. The Examiner is impermissibly using hindsight to use Applicant's patent application to reinterpret the prior art as suggesting the saved as and link command and functionality associated therewith to reject the pending claims. *See* MPEP § 2142 (stating "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.").

Even by impermissibly using hindsight, however, the Examiner has failed to show that the prior art teaches or suggests any saved as and linked comman nor the formation of at least one first link and a second link as required by claims 12-17 and 23-26. As noted above, the formation of a short cut and the saving of a file attachment relied upon by the Examiner is not the use of any saved as and linked command, nor does it teach or suggest the formation of one or more first links or a second link as required by claims 12-17 and 23-26 based on such a command being utilized.

C. Claims 18-22 And 27-30 Are Allowable Over The Cited Art

Claim 18 is directed to a device that includes an attachment substitution unit that replaces a file attachment of a received electronic message with a memory location link after user input is received that requires the file attachment to be saved and linked via actuation of a save as and link command. The device also includes a message link insertion unit that inserts a message link in a selected memory location when the file attachment is stored in the memory location in which the file attached to the electronic message is stored after the user input that requires the file attachment to be saved and linked via actuation of the save as and link command is received. The message link refers to the electronic message. Claims 19-22 and 27-29 depend directly or indirectly from claim 18 and, therefore, also contain this limitation.

Claims 18-22 and 27-30 were rejected as obvious in view of Microsoft Outlook 2002, the Windows XP OS system of October of 2001 and Coppinger et al. (Office Action, at 2-3).

As noted above with reference to claims 12-17 and 23-26, the cited art fails to teach or suggest any user input that requires a file attachment to be saved and linked and also requires units to insert a message link in a selected memory location when that user input is received and a fie attachment is saved in the memory location.

Microsoft Outlook 2002 and XP do not teach or suggest any saving of an attachment and also creating a link to the electronic message that initially has such an attachment when the attachment is saved. For example, there is no "save as and link" user input, command or functionality provided by Outlook 2002 and XP as noted in paragraphs 24-29 of the specification.

As may be appreciated from the screen shots of Figures 1-13 previously provided by the Examiner and referred to in the Office Action, a user must manually save an email to a desktop, then create a short cut link, then save the short cut link in the file in which an attachment is stored to be able to even save such a short cut in that file location by using Outlook 2002 and XP. There is no saving of an attachment while also creating and saving a link to the electronic message in the same file attachment that occurs when the attachment is saved.

Further, Coppinger et al. do not teach or suggest any message links or other links that refer to an electronic message nor the saving of such links in a file or other location in which an attachment from that electronic message is saved. In fact, the Examiner has correctly recognized that Coppinger et al. only deals with attachments of electronic messages. (Office Action, at 4).

For at least the above reasons, the cited art do not teach or suggest each and every limitation of claims 18-22 and 27-30. Therefore, the cited combination of art cannot render these claims obvious

D.   Claim 31 Is Allowable Over The Cited Art

Claim 31 is an independent claim and requires a device to include an attachment substitution unit that replaces a file attachment of a received electronic message with a memory location link when user input provides a save as and link command requiring the file attachment to be saved and linked in the file. The device also includes a message link insertion unit that inserts a message link in the file of the file system when the user input requires the file attachment to be saved and linked. The message link refers to the electronic message such that the message is displayed after the message link is actuated. The device also includes a control unit that controls the attachment substitution unit and message link insertion unit so that

attachment substitution and message link insertion occurs automatically when the user input requiring the file attachment to be saved and linked is provided to the device.

The cited art does not teach or suggest any attachment substitution unit configured to replace the file attachment of any received electronic message. As noted above, the cited art does not teach or suggest any message link insertion unit that inserts a message link in a file that also has a file attachment of that message stored therein when user input requires the file attachment to be saved and linked. In fact, none of the cited art teaches or suggests any device to act on user input that requires both saving of an attachment and linking to occur.

E.   **Granted European Patent No. EP 1 642 229**
       Shows The Pending Claims Are Allowable

The present application corresponds to granted European Patent No. EP 1 642 229B1. For the Examiner's reference, a copy of this patent was provided to the Examiner with the Amendment dated May 13, 2009. The European Patent Office has found the invention disclosed in the present application to warrant patent protection and includes claims that are similar in scope to those pending in the present U.S. patent application. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

II.   CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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